

### **REMARKS**

Claims 1-29 are pending in the Application. All claims stand rejected. In response to the Office Action made FINAL and mailed on July 27, 2005, the Applicant is now submitting a Substitute Declaration under 37 CFR § 1.132 with a Request for Continued Examination (RCE) as provided by MPEP §716.01(A)(4).

#### **1. Rejections under 35 U.S.C. § 102(a)**

Claims 1-29 have been rejected under 35 U.S.C. §102(a) as being clearly anticipated by Zachary et al. (CHI Systems Technical Report 001004.9915, entitled *Developing a Multi-Tasking Cognitive Agent Using the Cognet/iGen Integrative Architecture*). In response to the above rejection of the Office Action mailed on March 22, 2005, the applicant has submitted a declaration under 37 CFR § 1.132 indicating that he is the sole creator of the subject material disclosed in the technical report that has been claimed in the current application. In response to our response of June 13, 2005, the Examiner deemed the previously submitted rule 132 declaration defective and required clarification and or correction.

The Rule 132 Declaration has been revised and submitted herewith as the Examiner has required. The Substitute 132 declaration now clarifies that by the declarant stating he is "the sole creator of certain subject matter disclosed in the CHI Systems Technical Report 001004.9915 that has been claimed in the current patent application" he means "that certain subject matter is contained in the claims but does not constitute any entire claim."

The term "certain" has been inserted before "subject matter" to emphasize that it is only some subject matter disclosed in the Technical Report that is in the claims of the present invention. Dr. Zachary's use of the term "that" is consistent with this assertion. "That" is the restrictive pronoun, and thus, Dr. Zachary's statement restricts the subject matter

only to certain subject matter that may be contained in the claims. Had Dr. Zachary used the nonrestrictive pronoun "which", the meaning would have been different. (See E. B. White, *Strunk and White, Third Edition*, MacMillan Publishing Company, p.59.)

Regardless of the Examiner's interpretation of Dr. Zachary's Declaration, the 001004.9915 Technical Report (hereinafter "'9915 Technical Report'") is not prior art to the present application because it was published less than one year before filing of the present application. The Examiner assumes that the contributors or authors of the '9915 Technical Report are the inventors and therefore, states that the '9915 Technical Report is prior art under section 102(a) because it was "known or used by *others* (different inventive entity).". Nowhere in the publication is an identification made of the inventors. Therefore, the Examiner cannot assume that the authors are the inventors, and then state the inventive entity of what is disclosed in the '9915 Technical Report is different than inventive entity of the present application.

Additionally, it is a well established principle that an inventor's own work is not prior art unless it constitutes a statutory bar under Section 102(b) and that an applicant may eliminate a disclosure in a patent or publication by another by showing that the disclosure in fact derived from the applicant's own inventive work. (See *Chisum on Patents* § 3.08 [2](a). Therefore, if the '9915 Technical Report described the inventors' work, even though it was authored by others, it does not constitute prior art.

It is also noted that communication problems between the Applicants' former attorney, Mr. Yoshida, and Dr. Zachary led to Mr. Yoshida believing the '9915 Technical Report disclosed the claimed invention, which it does not. In particular, each had a different understanding of what is meant by "subject matter disclosed in the CHI Systems Technical Report 001004.9915 that has been claimed in the current patent application." There was no deceptive intent by either Mr. Yoshida or Dr. Zachary.

The Examiner has questioned and required the clarification and or correction based upon the Examiner's understanding that the previously submitted declaration is inconsistent with the inventorship of the current application. The inventorship is correct for the pending claims.

Any seemingly inaccurate statements made in the previously submitted Declaration or Office Action Response were made without deceptive intent. Since no deceptive intent of Dr. Zachary is involved in the original Declaration and the statement of the lack of deceptive intent of the inventor is included in Paragraph (7) of the Substitute Declaration, the Substitute Declaration should be accepted.

"An uncontradicted 'unequivocal statement' from the applicant regarding the subject matter disclosed in an article, patent, or published application will be accepted as establishing inventorship. *In re DeBaun*, 687 F.2d 459, 463, 214 USPQ 933, 936 (CCPA 1982)." See M.P.E.P. §716.10. According to the two examples in M.P.E.P. §716.10, "an affidavit under 37 CFR 1.132 may be submitted to show that the relevant portions of the reference originated with or were obtained from applicant" as in case of the currently submitted declaration with respect to the 102(a) reference page 700-280. The MPEP in the next sentence further explains that "the affidavit attempts to convert the fact situation from that described in Example 2 to the situation described in Example 1." After the conversion, the "reference cannot be used against applicant since it does not satisfy the 1-year time requirement of 35 U.S.C. 102(b)" as specified in Example 1 on page 700-279.

### **Specification**

The Examiner requested clarification with regard to whether the invention was developed pursuant to a government sponsored research project. The Applicants did not develop the invention pursuant to a government sponsored research project. The inventive technology was independently developed by CHI Systems, Inc. The 001004.9915 Technical Report was prepared to provide information on government applications of the invention.

### Information Disclosure Statement

The Information Disclosure Statement submitted with this Response includes Technical Report 000709.00001-05. This Technical Report describes the inventors' own work and as such is not prior art for the same reasons provided above with respect to the '9915 Technical Report. It is also noted that inventors are not designated in the Report. Only those contributing to the preparation of the report are designated.

### Conclusion

The Applicant has made an earnest effort to place this application in condition for allowance. If the Examiner feels that a telephone interview would expedite prosecution of this patent application, he is respectfully invited to telephone the undersigned.

Date:

July 26, 2004

By:

Respectfully submitted,  
SCHNADER HARRISON SEGAL & LEWIS LLP

Joan T. Kluger

Joan T. Kluger  
Reg. No. 38,940  
1600 Market Street, Suite 3600  
Philadelphia, PA 19103  
Tel: (215) 751-2357  
Fax: (215) 751-2205  
e-mail: jkluger@schnader.com  
Attorneys for Applicants